

R E M A R K S

A Request for Continued Examination and the requisite fee accompany this paper to remove the finality of the pending Office Action.

Claims 1 through 18 are in the application, with Claims 7 through 18 still withdrawn from consideration. Claims 1 and 6 have been amended in this paper, and are the independent claims herein. No new matter has been added. Reconsideration and further examination are respectfully requested.

Claim Rejections Under 35 USC § 101

Claims 1-6 are rejected as allegedly directed to non-statutory subject matter.

In explaining this rejection, the Examiner indicated that, apparently, he had disregarded language in claim 1 that recited “each of said computers running [now amended to read “executing”] said software program”, on the ground that this language was not clear. In view of the clarifying amendments made in this paper to claim 1 and discussed below, it is believed that claim 1, at least as now presented, clearly is directed to statutory subject matter.

Moreover, to further support the statutory status of claim 1, the claim has been further amended to recite, “using at least some of said computers to input said respective first input data by at least some of the audit firms to said computer program”. Still further, claim 1 now also recites, “each of said reports being generated by execution of a respective copy of said computer program on a respective one of said computers”.

Moreover, claim 6 now clearly recites, “using a plurality of computers to input respective first input data by each of a plurality of audit firms into a respective copy of a computer program”, as well as, “generating a respective current NOI audit report by executing each of said copies of said computer program on a respective computer of said plurality of computers”.

It is therefore respectfully requested that the rejection under § 101 be reconsidered and withdrawn.

Claim Rejections Under 35 USC § 112, 2nd Paragraph

Claims 1-6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

To overcome this rejection, claim 1 has been amended to remove the word “deployed”. Accordingly, it is believed now to be abundantly clear that each occurrence of “said computer program” refers to the first “computer program” that is recited.

To address the other point raised by the Examiner in connection with this rejection, claim 1 has been further amended to recite, “each of the audit firms having a respective computer of a plurality of computers, said deploying resulting in each of the computers executing said computer program”. Accordingly, there is now believed to be clear antecedent basis for the recitation in this phrase of “each of the computers”.

In view of the foregoing, it is respectfully requested that the rejection of claim 1 under § 112, be reconsidered and withdrawn.

Although the present Office Action indicated that independent claim 6 was also rejected under § 112, second paragraph, the Office Action did not point out any particular problem with the definiteness of claim 6. In any event, applicant has reviewed claim 6 and believes that the claim, at least as now presented, is sufficiently definite to satisfy the statute.

Claim Rejections Under 35 USC § 103(a)

Claims 1-6 are rejected as being unpatentable over Greif et al., U.S. Patent No. 5,371,675 (“Greif”).

Claim 1, as now presented, is directed to a “method” which includes “deploying a respective copy of a computer program to each of a plurality of audit firms”. Claim 1 further recites that “each of the audit firms operat[es] independently of each other and ha[s] a reporting relationship with a common investment entity” and that “each of the plurality of audit firms conduct[s] an audit of a respective real estate property and generat[es] an associated set of current net operating income (NOI) values”. It is further recited in claim 1 that “said computer program includ[es] an interactive global NOI audit model and user-viewable standards, procedures, documentation, and reporting requirements” and “said computer program operat[es] to receive a respective first input data in connection with the respective real estate property and to generate a respective current NOI audit report associated with said respective real estate property”. It is still further recited in claim 1 that “each of the audit firms ha[s] a respective computer of a plurality of computers” and that “said deploying result[s] in each of the computers executing said computer program”.

Claim 1 further recites “using at least some of said computers to input said respective first input data by at least some of the audit firms to said computer program”, and “receiving by the investment entity a plurality of current NOI audit reports”, where “each of said reports [is] generated by execution of a respective copy of said computer program on a respective one of said computers and reflect[s] said received respective first input data”. Finally, claim 1 recites that “all said received current NOI audit reports have been developed by substantially identical audit practices resulting from the audit firms using said interactive global NOI audit model and user-viewable standards, procedures, documentation, and reporting requirements”.

At the outset, applicant notes that the Examiner apparently gave little or no patentable weight to certain limitations of claim 1 as previously presented. These limitations, formerly prefaced by “for the purpose of”, “adapted to” or the like, have now been rewritten so as to be positively recited. These limitations include:

- each of the plurality of audit firms conducting an audit of a respective real estate property and generating an associated set of current net operating income (NOI) values; and
- said computer program operating to receive a respective first input data in connection with the respective real estate property and to generate a respective current NOI audit report associated with said respective real estate property.

It is believed that, at least as now recited, each of these limitations is now entitled to full patentable weight and serves to distinguish claim 1 from the Greif reference, upon which the Examiner relies.

Applicant further observes that in explaining the rejection of claim 1 under § 103, the Examiner failed to discuss, and thus apparently failed to consider, the claim limitation of “deploying a respective copy of a computer program to each of a plurality of audit firms”.

The Examiner asserts that having plural independent audit firms reporting to the same investment entity would be obvious, but nowhere does he address the patentability of deploying copies of a computer program to such audit firms. Even if it were obvious for such audit firms to work with a standard spreadsheet program, or the like (such as that disclosed in the Greif reference), nothing in the reference teaches or suggests deploying to each of a plurality of audit firms a respective copy of a computer program that “includ[es] an interactive global NOI audit model and user-viewable standards, procedures, documentation, and reporting requirements”, as

specified in claim 1. Indeed, the art of record completely lacks any teaching of such a computer program.

Although the Examiner appears to assert that Greif “discloses a computer program...for executing an audit associated with net operating income” (at the top of page 4 of the pending Office Action), it is believed that the reference does not support this assertion. The reference generally discloses a spreadsheet program that facilitates analysis of alternative (“what-if”) financial scenarios. Nothing in the reference refers in any way to auditing, much less NOI auditing.

It is therefore respectfully submitted that claim 1 clearly recites at least some limitations that are neither taught nor rendered obvious by the Greif reference. The rejection of claim 1 under § 103 should accordingly be reconsidered and withdrawn.

Claims 2-5 are dependent on claim 1 and are submitted as patentable on the same basis as claim 1.

Claim 6, as now presented, also recites using a computer program that “includ[es] an interactive global NOI audit model and user-viewable standards, procedures, documentation, and reporting requirements”, and accordingly is also believed to be patentable over the Greif reference.


CONCLUSION

Accordingly, Applicant respectfully requests allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the

present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-3460.

Respectfully submitted,

December²⁸, 2004
Date



Nathaniel Levin
Registration No. 34,860
Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840
(203) 972-3460